Cover sheet

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No new subject matter has been entered.

Claim Objections

The examiner objected claims 3 – 23 based on 37 CFR 1.75 (c) (#3). The inventors acknowledge this objection and modified the claims accordingly in order to avoid multiple dependent claims.

The examiner objected claims 24 – 45 as being a substantial duplicate of claims 1 – 23 (37 CFR 1.75) (#5). The inventors traverse this objection. At the same time, in order to comply with the claim rejections under 35 USC 112, the inventors modified the claims so that claim 1 refers to a "method", claim 24 to a "system".

Claim Rejections – 35 USC 112

The examiner rejected claims 1 and 2 as being indefinite (#7). The inventors acknowledge this objection, and claims 1 and 2 now refer to a "method" only. At the same time, the author amended claims 24 and 25 to refer to a "system" only (see also claim objection based on 37 CFR 1.75).

The examiner asked for clarification of "interrupt" vs. "superimpose" (#8). The inventors clarified this point by making only 3 mutually exclusive, collectively exhaustive divisions, i.e., the advertisement message part is played either before, after or overlapping with the music entertainment part. As for overlapping, there are two alternatives: The advertisement message part can either interrupt the music entertainment part (i.e., the music discontinues, the advertisement message part is played, and then the music re-continues) or is superimposed on the music entertainment part (i.e., the music does not discontinue and the advertisement message part is played at the same time as the music entertainment part, where the volume of the music entertainment part – in some embodiments – could be lower than the volume of the advertisement message part).

Claim Rejections – 35 USC 102

The examiner mentioned 3 prior art references of particular relevance to the present invention:

(1) U.S. patent 6,351,736 from Weisberg et al.

(2) U.S. patent 5,793,364 from Bolanos et al.

(3) U.S. patent 5,959,623 from Van Hoff et al.

As for (1), the inventors consider their invention to be distinct from and thus not anticipated by the invention of Weisberg et al. (U.S. patent 6,351,736) for the following reasons:

1. Weisberg et al. refer to "displaying" advertisements, i.e., providing visual data. The present invention focuses on audio data only. In that respect, the present invention does not need a monitor or screen in order to "display" the advertising message. Furthermore, Weisberg et al. mentions that the two types of data are of a different type, whereas the present invention claims they are identical (i.e., both digital audio data). Some quotes from U.S. patent 6,351,736 in support are as follows:
    a. "Claim 1: A system for playing data of a first data type while **displaying an advertisement** of a second data type, **the first data type being different than the second data type**, the system comprising: …"
    b. "Claim 2: The system of claim 1, wherein the data of the first data type is audio data and the **advertisement is visual data**."
    c. "Claim 30: A system for displaying data of a first data set in conjunction with **displaying an advertisement** of a second data set, the system comprising: …"
    d. "Claim 48: A method for displaying data of a first data set and **displaying an advertisement** of a second data set, ..."

e. The field of the invention starts with: "The present invention relates to a system and method for **displaying visual advertisements** with played data, and in particular, for displaying such advertisements in the format of **video data** while electronic files containing audio data and/or streaming audio data are played on a computer."

2. The examiner referred to a particular part of the Weisberg patent. I quote: "The present invention is of a method and a system for playing a first type of data, including but not limited to, audio stream data or audio data in an electronic file for example, for the user while **simultaneously displaying an advertisement** in the form of a **second type of data, such as video data** for example. The system and method enable advertisements to be displayed while data is played by the computer of the user, for example while music is being played from an audio file by the computer of the user, thereby providing an alternative revenue source for the owner of the rights to the data such as the music. **Furthermore, since the advertisement is in a data format, preferably video data, which is different from that of the audio music file, the display of such an advertisement does not interfere with the enjoyment of the music or other audio data being played.**" Here, again, Weisberg mentions the visual nature of the advertisement, whereas the present invention refers to audio data only. More importantly, Weisberg considers it a problem when the advertisement message is of the same data type as the entertainment message. The present invention however only refers to such instances, where the advertisement message has the same data type as the entertainment part. Thus, in the present invention – contrary to the teachings of Weisberg – the

advertisement part for sure **will interfere with the enjoyment of the music or other audio data being played.**

3. Weisberg further writes in his invention: "The first type of data should be different from the second type of data in the displayed and/or stored format. Therefore, if the first type of data is audio data, the advertisement is preferably displayed as video data, text data and/or graphic images, or a combination thereof. However, if the first type of data is video data, then the advertisement is preferably displayed as text data, graphic images, any other type of data which is different than the video data, or a combination thereof." This would not be applicable to the present invention, where the advertisement message and the entertainment parts are both of the same data type (audio data).
4. Furthermore, Weisberg does not include pure audio data as part of his definition of "video data". I quote: "Hereinafter, the term "video data" includes, but is not limited to, graphic still images, video stream data, animation, and displayed text data."
5. In addition, Weisberg's definition of "displaying" includes presentation of data through a different mechanism, whereas data are presented through the same mechanism in the present invention. I quote: "By "displaying" it is meant that the data is presented to the user in a suitable format, through a **different mechanism** than the first type of data is played."

Thus, the invention of Weisberg et al. is different from the present invention, even if they are linked by the same desired output, i.e., generating revenues from media consumption.

As for (2), the inventors consider their invention to be distinct from the invention of Bolanos et al. (U.S. patent 5,793,364) for the following reasons:

1. The invention of Bolanos et al. focuses on providing "a **graphical user interface** for playback of audiovisual programs, which **entices a user to choose to display an advertisement.** It is another object of the present invention to provide a g**raphical user interface** for playback of audiovisual programs, which includes a graphic interface element that draws attention to itself." This is different from the present invention as the present invention focuses on audio files, not on audiovisual programs or graphical user interfaces. Furthermore, Bolanos et al. offer a choice to display the advertisement, whereas in the present invention, no choice is given. As such, the invention of Bolanos et al. is different from the present invention, even if they are linked by the same desired output, i.e., generating revenues from media consumption. In particular, the present invention does not make use of any particular graphical user interface.
2. Furthermore, Bolanos et al. describe two distinct audiovisual programs. Yet, the present invention refers to a single digital audio file, i.e., not two separate files, where this single file links an advertisement message part with a music entertainment part.

As for (3), the inventors consider their invention to be distinct from the invention of Van Hoff et al. (U.S. patent 5,959,623) for the following reasons:

1. The invention of Van Hoff et al. refers to "informational images". Yet, the present invention refers to audio data, not visual data. I quote claim 1 of Van Hoff et al.: "A computer-implemented method for **displaying informational images on a display of a client computer** concurrently while said client computer executes an end user application program, the method comprising the steps of: …"

2. Furthermore, the invention of Van Hoff et al. focuses on the display of information on a computer screen or similar device. The present invention – as it refers to audio data – is not within the scope of U.S. patent 5,959,623.
3. In addition, the information is "user selectable" based on the teachings of Van Hoff et al. I quote: "In summary, the present invention is a method and apparatus for displaying **user selectable advertising information** or other **user selectable informational images** on a host computer." Contrary to that, based on the teachings of the present invention, the advertising information is not selectable, given that it is part of the same, one digital audio file as the music entertainment part.

Thus, the invention of Van Hoff et al. is different from the present invention, even if they are linked by the same desired output, i.e., generating revenues from media consumption. In particular, the present invention does not make use of user selectable informational images.

As for the other prior art references cited by the examiner, the inventors do not feel that they anticipate the present invention.

In particular, U.S. patents 5,222,189, 5,579,430, 6,291,756, 6,353,173, 6,515,212 and 6,658,383 describe digital encoding or storing processes used in creating digital audio files. Yet, the present invention does not claim a particular encoding process, but the combination of an advertisement message part with a music entertainment part as part of a digital audio file. This aspect is not covered in the aforementioned prior art references.

U.S. patents 5,715,314, 5,960,411 and 6,507,727 describe online network sales or distribution systems. Whereas such systems can be used in combination with the present invention, i.e., to purchase a digital audio file,

these prior art patents do not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file and thus do not anticipate the present invention.

U.S. patents 5,740,549 and 6,119,098 describe systems and methods for targeting and distributing advertisements over a distributed network. Whereas such as system can be used in combination with the present invention, i.e., to purchase and/or distribute a digital audio file, these prior art patents do not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file and thus do not anticipate the present invention. Moreover, those patents primarily refer to visual display of an advertisement, whereas the present invention only claims an acoustic "presentation" of an advertisement message part.

U.S. patent 5,848,397 describes an apparatus for scheduling the presentation of advertisements on a computer monitor. Given that a computer monitor refers to a visual presentation and the present invention claims only acoustic presentation, this prior art reference does not anticipate the present invention. The inventors of that prior art reference also consider e-mail as application for their invention, not digital music files.

U.S. patent 5,948,061 describes methods and apparatuses for targeting the delivery of advertisements over a network, where statistics are compiled on individual users and networks and the use of the advertisements is tracked. Whereas such as system can be used in combination with the present invention, i.e., to monitor and track the digital audio files of the present invention, this prior art patent does not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file and thus does not anticipate the present invention.

U.S. patents 6,385,306 6,647,417 describe methods for transmitting or distributing audio files. Whereas such methods can be used in

combination with the present invention, i.e., to transmit a digital audio file of the present invention, these prior art patents do not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file and thus do not anticipate the present invention.

U.S. patent 6,541,689 focuses on non-pre-recorded digital streams. Yet, the present invention – by claiming a digital audio file – only focuses on pre-recorded digital audio files. Furthermore, the present invention does not claim streams. As such, this prior art reference does not apply to the present invention and also does not anticipate the present invention. Moreover, this prior art patent does not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file.

To summarize: The prior art references cited by the examiner can be generally classified into one of the following categories:

1. Prior art references in respect to advertisements
2. Prior art references in respect to encoding, recording or storing digital audio files.
3. Prior art references in respect to tracking, transmitting, distributing and/or selling digital content.

Whereas prior art references of categories 2 and 3 can be used in combination with the present invention (e.g., to create the digital audio files of the present invention, to distribute the digital audio files of the present invention, to mediate the sales of the digital audio files of the present invention), the prior art references of categories 2 and 3 do not claim the combination of an advertisement message part with a music entertainment part as part of a digital audio file and thus do not anticipate the present invention.

As for category 1 in general and U.S. patent 6,351,736 in particular, these prior art references focus generally on visual advertisements, whereas the

present invention is limited to acoustic presentation of advertisements. Furthermore, none of the prior art references explicitly claims the combination of an advertisement message part with a music entertainment part as part of a single digital audio file, and thus the present invention is not anticipated.